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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,800	03/15/2005	Hikofumi Yamamoto	052277	9561

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EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,800

Applicant(s)

YAMAMOTO ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Examiner is referring to the Japanese reference mentioned on pages 1 and 2 of the specification.

Drawings

2. Figures 6 and 7 should be designated by a legend such as --Prior Art--- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 2 of claim 8 Applicant claims "assuming an outside diameter...." Examiner notes that the use of the term "assuming" is indefinite since it fails to clearly set forth the metes and bounds of the claim. Claim 9 is rejected due to its dependency from claim 8.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5, 6, 8, and 9 are rejected under 35 U.S.C. 102(e2) as being anticipated by US Patent 6505822 to Yamamoto et al.

Re: claims 1, 2, 5, 8, and 9. Yamamoto et al. show in figure 1 a hydraulic style vibration proof device comprising: a cylindrical fitting 41, a first attachment fitting 21, a vibration isolating base made of rubber elastomer 4 coupling an upper end opening of the cylindrical fitting and the first attachment fitting; a diaphragm 6 disposed to oppose the vibration isolating base and forming a liquid chamber 5 between the vibration isolating base and the diaphragm within the cylindrical fitting, and a cup shaped second

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attachment fitting 3,7,11,12 attached to a lower end opening of the cylindrical fitting and forming an air chamber 8 between the second attachment fitting and the diaphragm, which is characterized in that the second attachment fitting is fabricated from aluminum at least portion 11 of which is fabricated from aluminum and includes a peripheral wall portion shown in the area of the lead line of 7, a bottom wall portion 3a formed to be thicker in wall thickness than the peripheral wall portion and a curved portion shown in the area around 71 interposed between the bottom wall portion and the peripheral wall portion and curved in an arc form in axial cross-section, the bottom wall portion defined with a through hole shown surrounding 3b and has a bolt 3b having a serration portion below its head as shown press fitted in the through hole and provided fixedly to the second attachment fitting such a manner that the bolt juts out from the second attachment fitting downwardly as shown.

Re: claim 6. Yamamoto et al. show a length of the serration portion being set to be shorter than a depth of the through-hole as shown, thus providing the non-serration bonding portion between the serration portion (particularly the top of the serration portion) and a lower end opening face of the through hole.

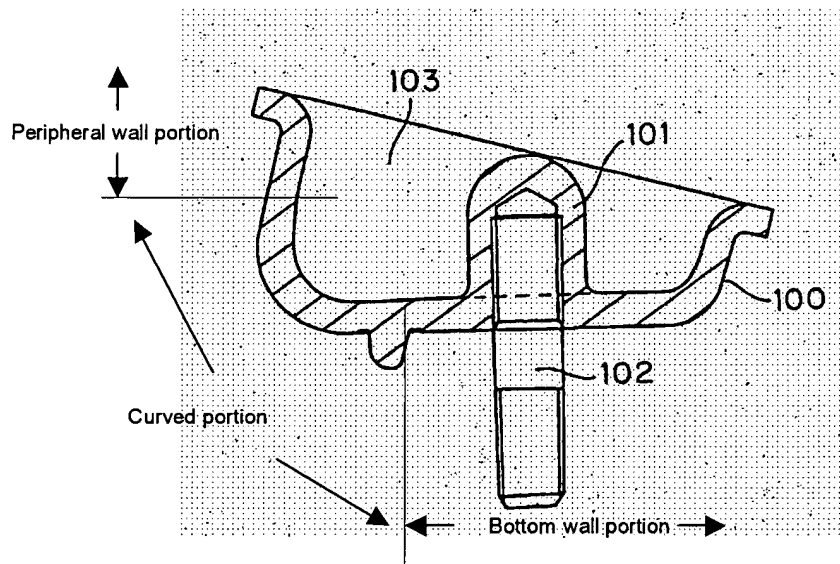
Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior art figure 6 in view of JP-4114145 (JP'145).

Re: claims 1-3, 5. Prior art figure 6 shows a hydraulic vibration proof device comprising: a cup-shaped second attachment 100 forming an air chamber 103 which is characterized in that the second attachment fitting is fabricated from aluminum as disclosed in paragraph [0007] and includes a peripheral wall portion and a curved portion interposed between the bottom wall portion and the peripheral wall portion and curved in an arc form in axial cross-section, the bottom wall portion is defined with a hole and having a bolt.



Prior art figure 6 is silent with regards to the remaining structure of the vibration proof device and lacks the claimed through hole and bolt arrangement on the bottom wall portion.

JP'145 teaches in figure 1 the use of a vibration proof device comprising a cylindrical fitting 1, a first attachment fitting 9, a vibration isolating base made of rubber elastomer 2 coupling an upper end opening of the cylindrical fitting and the first attachment fitting, a diaphragm 3 disposed to oppose the vibration isolating base and forming a liquid chamber between the vibration isolating base and the diaphragm within the cylindrical fitting, and a cup-shaped second attachment 7 fitting attached to a lower end opening of the cylindrical fitting and forming an air chamber 8 between the second attachment fitting and the diaphragm, which is characterized with a bottom wall portion shown to the left of the lead line of number 7 defined with a through hole and has a bolt 11 having a serration portion 10 below its head press-fitted in the through hole and provided fixedly to the second attachment fitting in such a manner that the bolt juts out from the second attachment fitting downwardly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the structure of the vibration proof device of prior art figure 6 to have included a cylindrical fitting, a first attachment fitting, a vibration isolating base made of rubber elastomer, and a diaphragm as taught by JP'145, in order to provide a structure that provides damping between two vehicle components in an axial direction.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bolt and hole arrangement on the bottom wall portion to have been a bolt jutting out downwardly from a through-hole, as taught by JP'145, in order to provide a means of more effectively securing the bolt against fall out.

Re: claims 8 and 9. With regards to the relationship of the different device portions, Examiner maintains that obviousness is found on the basis of "routine experimentation with a very limited number of species". In re Jones, 162 USPQ 224 (CCPA 1969). With regards to the optimum range of 3 and up or 5 and up, Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bonding index to have been 3 or 5 and up since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior art figure 6 in view of JP-4114145 (JP'145) as applied above, and further in view of JP-6300079 (JP'079).

Prior art figure 6, as modified, lacks the limitation of a sealing agent between the bolt and the second attachment fitting.

JP'079 teaches in figure 4 the use of a sealing agent 42 between the bolt 6 and the second attachment fitting 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the space between the bolt and the second attachment fitting of prior art figure 6, as modified, to have included a sealing agent, as taught by JP'079, in order to provide a means of preventing the entrance of debris.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6505822 to Yamamoto et al. in view of US Patent 4762310 to Krajewski et al.

Yamamoto et al. teach in figure 1 the use of a lower end opening face of the through hole providing the non-serration bonding portion, but lacks the limitation of the lower end opening face being chamfered.

Krajewski et al. teach in the figure on the front of the patent the use of a through hole within element 26 which is shown on its lower end opening face as being chamfered.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lower end opening of the through hole to have been chamfered, as taught by Krajewski et al., in order to provide enhanced frictional engagement.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent/Application 2006/0097436 to Yamamoto and US Patents: 6514061 to Yamamoto et al. and 6257562 to Takashima et al. teach the use of vibration proof devices including a second fitting attachment in the form of a cup and a bolt extending downward from a through hole in the bottom wall portion of the second fitting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
August 3, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683

8/3/06